



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/213,581	12/17/1998	IHOR LYS	CKC-012.07	6707

23628 7590 06/17/2003

WOLF GREENFIELD & SACKS, PC
FEDERAL RESERVE PLAZA
600 ATLANTIC AVENUE
BOSTON, MA 02210-2211

EXAMINER

LEE, WILSON

ART UNIT PAPER NUMBER

2821

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/213,581

Applicant(s)

LYS ET AL.

Examiner

Wilson Lee

Art Unit

2821

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,8-26,41,42,45-48,50-54 and 56-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,2,8-26,41,42,45-48,50-54 and 56-76 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.


Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- 58, 59, 60, 73
- 
- I. Claims 1, 2, 8-26, 58-60 and 68-76 drawn to a method of illuminating a retail display, classified in class 340, subclass 572.1.
 - II. Claims 41 and 61, drawn to a non-opaque container lighting system apparatus, classified in class 362, subclass 153.1.
 - III. Claims 42 and 62, drawn to a lighting system vending machine, classified in class 362, subclass 32.
 - IV. Claims 45-50 and 63-65, drawn to a wearable lighting device, classified in class 362, subclass 108.
 - V. Claims 51-57, drawn to a method of illuminating a retail display by direct illumination, classified in class 315, subclass 291.
 - VI. Claims 66 and 67, drawn to a method of attracting attention from an observer on a transparent areas (e.g. stencil or gobo), classified in class 362, subclass 284.

The inventions are distinct, each from the other because of the following reasons:

Inventions II-IV and I, V, VI are related as products and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as

Art Unit: 2821

claimed in Groups II-IV may be used in a process different from Groups I, V, VI such as rendering illumination without any color. And process of use as claimed in Groups I, V, VI may be used in a device without any addressable controller having alterable address.

Inventions I, V and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as illuminating an information board. Invention V illuminates object directly that is different from the indirect illumination as required by Inventions I and VI.

Invention VI has separate utility such as illuminating a stencil or gobo. See MPEP § 806.05(d).

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as lighting up a non-opaque container. Invention III has separate utility such as lighting up a vending machine. See MPEP § 806.05(d).

Inventions II & III and IV are unrelated products. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions II & III require addressable controller and receiver. The system described in the claims of Inventions II & III are not capable of being used in Invention IV because Inventions II & III are too big to be installed on a wearable clothing. And Invention IV is capable of recording data,

Art Unit: 2821

replaying the recorded data, receiving data from a transmitter that Inventions II & III are not capable of. Inventions II & III is operated by the control signals from an addressable controller, on the other hand, Invention IV is operated by data from an external transmitter.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

An election of a particular species as described below is required in the instance where the invention of Group I is elected.

Claims 1, 2, 17, 18, 22-26, 68, 74-76 are generic to a plurality of disclosed patentably distinct species comprising the followings:

- Species 1: a beverage container defined by claims 8-13 and 71, and illustrated in Figure 99.
- Species 2: a display sign defined by claim 14, and illustrated in Figure 46.
- Species 3: an information board defined by claims 15, 16, 19-21 and 72, and illustrated in Figure 49. { 58, 59, 60, 73 }
- Species 4: a display case defined by claim 69, and illustrated in Figure 48.
- Species 5: a vending machine defined by claim 70, and illustrated in Figure 98.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A shorten statutory period for response to this action is set to expire thirty days from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned.

Remarks

The finality of this application is withdrawn. The restriction requirement is established in order to simplify the burden on prosecution.

Correspondence

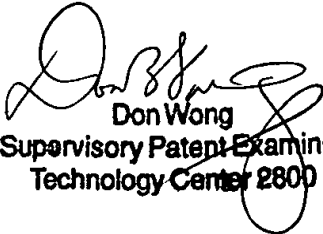
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wilson Lee whose telephone number is 703-306-3426.

Art Unit: 2821

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 703-308-4856. The fax phone numbers for the organization where this application or proceeding is assigned is 703-308-7722 or 703-308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

WL
June 14, 2003


Don Wong
Supervisory Patent Examiner
Technology Center 2800